UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,813	12/05/2003	Biplav Srivastava	JP920030179US1	1921

7590 10/19/2006

Frederick W. Gibb, III
McGinn & Gibb, PLLC
Suite 304
2568-A Riva Road
Annapolis, MD 21401

EXAMINER	
PANNALA, SATHYANARAYA R	

ART UNIT	PAPER NUMBER
2164	

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/729,813	SRIVASTAVA, BIPLAV	
	Examiner	Art Unit	
	Sathyanarayan Pannala	2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 July 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's Amendment filed on 7/27/2006 has been entered including amended claims 1-15. In this Office Action, claims 1-15 are pending.

Specification

2. The revised Abstract of the invention filed on 7/27/2006 is objected because it is same as the claim 1. A brief abstract of the technical disclosure in the specification must commence on a separate sheet, preferably following the claims, under the heading "Abstract" or "Abstract of the Disclosure." The sheet or sheets presenting the abstract may not include other parts of the application or other material. The abstract in an application filed under 35 U.S.C. 111 may not exceed 150 words in length. The purpose of the abstract is to enable the United States Patent and Trademark Office and the public generally to determine quickly from a cursory inspection the nature and gist of the technical disclosure, see 37 C.F.R. *§ 1.72.*

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-15, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Undue experimentation and ingenuity would be required beyond one ordinarily skilled in the art to practice for the following reasons:

a) Interpreting codified provisions.

b) Codified provisions concerning events as computer programming language declarative statements.

c) Evaluation functions as logical conditions.

d) Evaluating computer programming language declarative statements.

e) Extraction of a rule.

5. Claims 1 and 8-9 are rejected under 35 U.S.C. 112, second paragraph, as a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74

(Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 1 and 8-9 recites the broad recitation "conducting a search of documents pertaining to customized user-related interests in a computerized database", and the claim also recites "storing codified provisions concerning events of a document as rules computer programming language declarative statements that use logical expressions to represent a logical structure of said codified provisions" which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCollum et al. (USPA Pub. 2005/0091640 A1) hereinafter McCollum, in view of Nikander et al. (US Patent 6,253,321) hereinafter Nikander, and in view of Hatton (US Patent 6,269,356) hereinafter Hatton.

8. As per independent claims 1, 8-9, McCollum teaches a rules definition language that includes statements facilitate efficient use of computer resources by allowing a rule to be broken down into one or more instructions and processing these instructions asynchronously to provide more efficient use of computer resources (page 1, paragraph [0005]). McCollum teaches the claimed, storing evaluation functions as logical conditions relating to the stored rules (page 15, paragraph [0182]). McCollum teaches the claimed, evaluating the rules using at least one of the stored evaluation functions for an event concerning the codified provisions (page 16, paragraph [0189]). McCollum does not explicitly teach codified provisions concerning events. However, Nikander teaches the claimed, storing codified provisions concerning events as rules that use logical expressions to represent a logical structure of the codified provisions (col. 3, lines 15-25). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention, to have combined the teachings of the cited references because Nikander's teachings would have allowed McCollum's method to eliminate bottleneck of performance by reducing the processing overhead consisting of looking up for policy rules from a database (col. 3, lines 47-49).

McCollum and Nikander do not explicitly teach searching and displaying declarative statements. However, Hatton teaches the claimed, conducting a search of documents pertaining to customized user-related interests in a computerized database (Fig. 1, col. 12, lines 46-55). Hatton teaches the claimed, presenting the evaluated computer programming language declarative statements to a user as a search result (Fig. 1, col. 12, line 66 to col. 13, line 5). Thus, it would have been obvious to one of

ordinary skill in the data processing art at the time of the invention, to have combined the teachings of the cited references because Hatton's teachings would have allowed McCollum's method to eliminate drawbacks of expert systems by teaching human creativity and problem solving to a user whenever query a database (col. 1, lines 24-28).

9. As per dependent claims 2, 10, McCollum does not explicitly teach mapping codes to computer programming language declarative statements. However, Nikander teaches the claimed, "mapping said codified provisions to computer programming language declarative statements (Fig. 5, col. 7, lines 57-67). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention, to have combined the teachings of the cited references because Nikander's teachings would have allowed McCollum's method to eliminate bottleneck of performance by reducing the processing overhead consisting of looking up for policy rules from a database (col. 3, lines 47-49).

10. As per dependent claims 3, 11, McCollum teaches the claimed, the step of restricting the computer programming language declarative statements that are evaluated using the evaluation functions (Fig. 2, page 3, paragraph [0034]).

11. As per dependent claims 4, 12, McCollum teaches the claimed, extracting rules system parameters from text of said codified provisions and populating rules system templates using the extracted rules system parameters (page 8, paragraph [0099]).

12. As per dependent claims 5, 13, McCollum teaches the claimed, the computer programming language declarative statements are expressed in a scripting rules system (page 9, paragraph [0104]) .

13. As per dependent claims 6, 14, McCollum teaches the claimed, the computer programming language declarative statements are expressed in the if-then-else rules system (page 9, paragraph [0108]).

14. As per dependent claims 7, 15, McCollum teaches the claimed, codified provisions relate to a legal code (page 15, paragraph [0188]).

Response to Arguments

15. Applicant's arguments filed 7/25/2006 have been fully considered but they are not persuasive and details as follows:

a) Applicant's argument stated as "the Applicant has amended the abstract to place it in compliance with 37 CFR 1.72."

In response to Applicant's argument, Examiner respectfully disagrees with the amendment because, the amended Abstract is a copy of claim 1.

b) Applicant's argument stated as "The amended claims when read with respect to the specification and drawings clearly provides proper enablement for one of ordinary skill in the art."

In response to Applicant's argument, Examiner respectfully disagrees with the amendment because, claims are very broad with reference to the specification and drawings.

c) Applicant's argument stated as "the Applicant has amended claim 1-15 to provide more than merely an abstract idea."

In response to Applicant's argument, Examiner respectfully agrees with the claims amendment and the rejection under 35 USC 101 is withdrawn.

d) Response to Rule 131 declaration:

i) Applicant's argument stated as "submitted herewith is a Rule 131 declaration swearing behind the McCollum reference."

In response to Applicant's argument, Examiner respectfully disagrees with the submitted Rule 131 declaration, because of the following reasons:

The declaration filed on 7/27/2006 under 37 CFR 1.131has been considered but it is ineffective to overcome the McCollum et al. (USPA Pub. 2005/0091640 A1) reference.

Applicant states that the invention was conceived and reduced to practice, as evidenced by the exhibit A comprising documentation and exhibit B comprising PowerPoint slides printout.

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). **Applicant must give a clear explanation of the exhibits pointing out exactly what facts** are established and relied on by applicant 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit 'asserts that facts exist but does not tell what they are or when they occurred.").

In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose.

The affidavit or declaration and exhibits must clearly explain which facts or data relating to claims. The declaration does not clearly explain which facts or data Applicant is relying on to show completion of the invention prior to October 24, 2003. The declaration comprises vague and general statements in broad terms about what the exhibit describes along with a general assertion that the exhibit demonstrates a reduction to practice. Thus, the declaration amounts to a mere pleading unsupported by proof or a showing of facts.

For example, the independent claim 1 is claiming as "**A method for interpreting codified provisions, said method comprising:**" corresponding to which part of Applicant's work?

The limitations of claim 1,

"conducting a search of documents pertaining to customized user-related interests in a computerized database;

storing codified provisions of a document as computer programming language declarative statements that use logical expressions to represent a logical structure of said codified provisions;

storing evaluation functions comprising computerized logic code representing said customized user-related interests in said document and related to said computer programming language declarative statements;

evaluating said computer programming language declarative statements using at least one of the stored evaluation functions for an event concerning the said codified provisions; and

presenting the evaluated computer programming language declarative statements to a user as a search result." corresponding to which part of Applicant's work.

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sathyanarayan Pannala whose telephone number is (571) 272-4115. The examiner can normally be reached on 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sathyanarayan Pannala
Examiner

srp
October 13, 2006

MOHAMMAD ALI
PRIMARY EXAMINER